

Notice of Allowability

Application No.

10/527,587

Examiner

FEREYDOUN G. SAJJADI

Applicant(s)

BESCHORNER ET AL.

Art Unit

1633

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/17/2009.
2. ☒ The allowed claim(s) is/are 1-18 and 20-22.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date ____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 7/6/2009.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

/Fereydoun G Sajjadi/
Primary Examiner, Art Unit 1633

DETAILED ACTION - ALLOWANCE

Claim Status

Applicants' amendment filed April 17, 2009, in response to the Office action dated October 17, 2008 has been entered. Claims 1-22 are pending in the application. Claim 5 has been amended. No claims were cancelled or newly added. Claims 4 and 6 remain withdrawn from consideration, without traverse. Claims 1-3, 5 and 7-22 are currently under examination.

Claims 1, 2, 5, 7, 8 and 13-21 were rejected under 35 U.S.C. §102(e) as being anticipated by Wu et al. (U.S. Patent No.: 6,995,299; filed Aug. 15, 2001), in the previous Office action dated October 17, 2008.

Claims 1, 3 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wu et al. (U.S. Patent No.: 6,995,299; filed Aug. 15, 2001), in view of Loeb et al. (U.S. Patent No: 6,451,571; filed Sep. 17, 2002), in the previous Office action dated October 17, 2008.

Claims 1 and 9-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (U.S. Patent No.: 6,995,299; filed Aug. 15, 2001), in view of Sorscher et al. (U.S. Patent No.: 6,017,896; filed Jun. 24, 1997), in the previous Office action dated October 17, 2008.

Applicants have supplied a Declaration under 37 C.F.R. §1.131, antedating the reference of Wu et al. to a date before November 2, 1999. As the Wu et al. reference is no longer available as prior art, the rejections are hereby withdrawn.

The restriction requirement between claim 6 (subject matter of Group I) and Group II as set forth in the Office action mailed on May 15, 2007 has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Accordingly, all withdrawn species have been rejoined, and claims 4 and 6 are hereby rejoined with claims 1-3, 5 and 7-22. Rejoined claims 4 and 6 are further considered allowable.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may

be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Lisa M. Hemmendinger on July 6, 2009.

The application has been amended as follows:

In the claims,

Claim 19 has been cancelled.

REASONS FOR ALLOWANCE:

The following is an examiner's statement of reasons for allowance:

The closest prior art is that of Wu et al., no longer available as prior art for reasons set forth above. While in utero transplantation of foreign cells to a fetus was previously known, the prior art of record did not teach or suggest a method of engrafting the foreign cells following the selective destruction of native cells in a non-human fetus (expressing a suicide gene product), prior to said transplantation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 1-18 and 20-22 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FEREYDOUN G. SAJJADI whose telephone number is (571)272-3311. The examiner can normally be reached on 6:30 AM-3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fereydoun G Sajjadi/
Primary Examiner, Art Unit 1633